

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 3 and 18 have been canceled. Claims 1-2, 4-17, and 19-22 are pending, of which claims 1, 4, 6-8, 14, and 19-20 have been  
5 amended. The amendment to claim 8 is simply to correct an informality, and is not to overcome prior art.

#### **Allowable Subject Matter**

Claims 3-4 and 6-7 are indicated as being allowable if rewritten in  
10 independent form (*Office Action* p.4). Applicant appreciates the indication of allowability and believes that the claims are allowable because the prior art fails to teach, anticipate, or render obvious the invention as claimed.

Independent claim 1 is amended to include allowable features of claim 3 (now canceled). Accordingly, claim 1 along with dependent claims 2 and 4-7 are  
15 in condition for allowance. Applicant respectfully requests that the objection to claims 4 and 6-7 be withdrawn.

#### **Claim Objection**

Claim 8 is objected to for an informality (*Office Action* p.2).  
20 Appropriate correction has been provided herein, and Applicant respectfully requests that the objection to claim 8 be withdrawn.

#### **35 U.S.C. §101 Double Patenting Rejection**

Claims 8-22 of the present application are rejected under 35 U.S.C. §101  
25 for double patenting over claims 11-29 of U.S. Patent No. 6,637,858 which is the parent application, Serial No. 10/016,466 filed October 30, 2001. Applicant disagrees, however, that the double patenting rejection of claims

8-22 is proper. For example, claim 8 of the present application does not recite the same invention as independent claim 11 of the '858 Patent.

Claim 8 recites "a hinged printbar assembly comprising a framework configured to engage a wiper assembly when the hinged printbar assembly is in  
5 a service position, the framework further configured to disengage from the wiper assembly such that the hinged printbar assembly pivots from the service position to a print position".

Claim 11 of the '858 Patent recites "a hinged printbar assembly comprising a framework that includes a guide configured to engage a guidable  
10 member of a wiper assembly". Claim 11 of the '858 Patent does not include a service or print position as recited in claim 8, and claim 8 does not include a guide or guidable member as recited in claim 11. Clearly, claims 8 and 11 are drawn to "different inventions" for purposes of this discussion.

According to MPEP §804, paragraph II.A, "same invention" means  
15 identical subject matter. The test for statutory double patenting is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In this case, it would be possible to infringe claim 8 of the present application without infringing claim 11 of the '858 Patent. Therefore, the two claims are not drawn to the "same invention",  
20 and the §101 rejection should be withdrawn.

Further, claim 8 of the present application does not recite the same invention as independent claims 17 and 26 of the '858 Patent. Claim 17 recites "transferring an imaging medium onto a print media", and both claims 17 and 26 recite "engaging a guide of the printbar assembly with a guidable member  
25 of a wiper assembly". Claims 17 and 26 of the '858 patent do not include a printbar assembly framework configured to engage a wiper assembly as recited in claim 8, and claim 8 does not include transferring an imaging medium or a

guide and guidable member as recited in claims 17 and/or 26. Accordingly, claim 8 is not drawn to the "same invention" as claims 17 and 26 of the '858 Patent, and the §101 rejection should be withdrawn. Additionally, claims 9-13 are therefore allowable by virtue of their dependency upon claim 8.

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Claim 14 of the present application also does not recite the same invention as independent claims 11, 17, and 26 of the '858 Patent. Claim 14 is amended herein and recites "engaging a framework of the printbar assembly with a wiper assembly" and "maintaining contact between the one or more  
10 printheads and one or more wipers coupled to the wiper assembly via an interaction of the framework of the printbar assembly with the wiper assembly".

Claims 11, 17, and 26 of the '858 Patent do not recite any such feature of engaging a framework of the printbar assembly with a wiper assembly, or  
15 maintaining contact between printheads and wipers, as recited in claim 14. Accordingly, claim 14 is not drawn to the "same invention" as claims 11, 17, and 26 of the '858 Patent, and the §101 rejection should be withdrawn. Additionally, claims 15-17 and 19-22 are therefore allowable by virtue of their dependency upon claim 14.

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### 35 U.S.C. §103 Claim Rejections

Claims 1-2, 5, 14, 17, 19, and 21 are rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,534,897 to Anderson et al. in view of U.S. Patent No. 6,578,945 to Hashi et al. (*Office Action* p.3).

25 Independent claim 1 is amended to include allowable subject matter, as described above. Additionally, claim 14 is amended to include allowable features of claim 18 (now canceled). Accordingly, claims 2 and 4-7 are allowable by virtue

of their dependency upon claim 1, and claims 15-17 and 19-22 are allowable by virtue of their dependency upon claim 14. Applicant respectfully requests that the §103 rejection be withdrawn.

5        **Conclusion**

Pending claims 1-2, 4-17, and 19-22 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. If any issues remain that preclude issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a  
10        subsequent Action.

Respectfully Submitted,

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